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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,739	01/02/2002	Thomas J. Taylor	6976 C	3736

7590 02/07/2005

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Intellectual Property (R41B)
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EXAMINER	
REDDICK, MARIE L	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,739	TAYLOR ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/25/04 & 11/10/04*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1,5,7,8 and 10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,7,8 and 10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Amendment + Affidavits filed on 11/10/04 are sufficient to remove the rejection under 35 USC § 112, 2nd paragraph, as applied to claims 1, 5, 7, 8, 10, 11, 13-15, 17 & 20 (11/17/04, paragraph no. 4) and the rejection under 35 USC § 102 (b or e)/103 (a), as applied to claims 1, 5, 7, 8 & 10-20 (11/17/04, paragraph no. 8), over Arkens et al (U.S. 5,427,587), Arkens et al (U.S. 5,661,213), Arkens et al (U.S. 5,763,524), Arkens et al (U.S. 6,136,916), Chen et al (U.S. 6,274,661 B1) and EP 583,068 A1 (Arkens et al). The finality of the rejection of the Office Action (11/17/04), which crossed in the mail with the aforementioned Amendment + Affidavits, is herein withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 5, 7, 8 & 10-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Strauss (U.S. 5,318,990).

Strauss teaches a fibrous glass binder, for application to a fibrous glass mat useful as a thermal or acoustical insulation product, defined basically as containing an aqueous solution of a polycarboxy polymer which includes homo- and copolymers prepared from unsaturated carboxylic acids, a trihydric alcohol such as triethanol amine and a catalyst such as sodium hypophosphite and sodium phosphite and mixtures thereof (the Abstract, col. 1, lines 5-10, col. 2, lines 2-11 & 15-68, col. 3, lines 1-21 & 59-66 & the claims). Strauss further specifically teaches that the ratio of polycarboxy

polymer to trihydric alcohol can be determined by comparing the ratio of moles of hydroxyl groups contained in the trihydric alcohol to the moles of carboxy groups contained in the polycarboxy polymer wherein the stoichiometric ratio is from about 0.5 to about 1.5 and preferably about 0.7 to about 1.0 (col. 3, lines 22-31). Strauss further teaches that the binders can contain additional conventional adjuvants such as coupling agents, dyes, oils, fillers, etc. (col. 3, lines 53-58). More specifically, Strauss exemplifies binder formulations containing polyacrylic acid, a trihydric alcohol such as glycerol and trimethylopropane, sodium hypophosphite & water wherein the polyacrylic acid component has a MW = 2,100 and 5,100 and wherein the ratio of equivalents of hydroxyl groups to equivalents of carboxy groups overlaps in scope with the claimed range (Runs 1-4). Strauss therefore anticipates the instantly claimed invention with the understanding that the fiberglass binder and product of Strauss overlap in scope with the fiberglass binder and product therefrom, as claimed.

As to the viscosity limitation, as claimed, it would be expected that the viscosity of the binder solutions of Strauss, if measured under the same conditions as applicant, would possess such since the binder solutions of Strauss are essentially the same as and made under essentially the same conditions as the claimed binder solutions. The onus to show otherwise is shifted to applicant to show that this, in fact, is not the case.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of In re Best, 195 USPQ 430, 433(CCPA 1977); In re Fitzgerald et al, 205 USPQ 594.

Even if it turns out that Strauss does not anticipate the claims, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Strauss, the precisely defined fiberglass binder and product therefrom, as claimed, as per such having been within the purview of the general disclosure of Strauss and with a reasonable expectation of success.

As to the dependent claims, if not taught or suggested, the limitations would have been obvious to the skilled artisan and with a reasonable expectation of success. That is, any additional or particular claim parameters which may not be

specifically set out in the reference are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 7, 8 and 10-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,331,350. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S.'350 defined, basically, as a fiberglass binder comprising an aqueous solution of a polycarboxy polymer governed by a number average MW of less than 5,000, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of carboxyl group equivalents to hydroxyl group equivalents is in the range of from about 1/0.65 to 1/0.75 clearly overlap in scope with the instantly claimed invention which is defined basically as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer having a molecular weight of 5,000 or less, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of equivalents of hydroxyl groups to equivalents of carboxyl groups is in the range of from 0.6/1 to 0.8/1. The viscosity limitation, as instantly claimed, would be expected to be an inherent property in the claimed invention of U.S. Patent No.'350 especially when interpreted in light of the Runs B, C & D of U.S. Patent No.'350 which supports anticipation of the claimed invention. See In re Boylan, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968) & In re Vogel, 422 F.2d 438, 441-442, USPQ 619, 622 (CCCPA 1970).

Evidence of Common Ownership

6. Claims 1, 5, 7, 8 and 10-20 are directed to an invention not patentably distinct from claims 1-24 of commonly assigned U.S. Patent 6,331,350 B1 as per reasons stated per paragraph no. 5.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent 6,331,350, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

6. Applicant's arguments filed 11/10/04 have been fully considered but they are not persuasive.

Relative to the OTDP rejection over the claims of U.S. 6,331,350---- It is urged and maintained that the claims of U.S. Patent No.'350 defined, basically, as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer governed by a number average MW of less than 5,000, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein the ratio of carboxy group equivalents to hydroxyl group equivalents is in the range of from about 1/0.65 to 1/0.75 clearly overlap in scope with the instantly claimed invention which is defined basically as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer having a molecular weight of 5,000 or less and a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of equivalents of hydroxyl groups to equivalents of carboxyl groups is in the range of from 0.6/1 to 0.8/1 and wherein the viscosity of the binder solution, at 25 degrees C and 40 % solids, is from about 20 cP to about 100 cP. To this end, the Double Patenting rejection is deemed proper and stands.

As to the pH recited in the claims of U.S. Patent '350, the instant claims do not require that this limitation be met.

As to the Declaration under 37 CFR § 1.132---- While Counsel argues that the viscosity range of from 20 cP to 100 cP at 25 degrees C and 40 % solids is not an inherent feature of the binder system and relies on the 1.132 Declaration to support this allegation, the Declaration appears to be one of opinion from an interested party. Furthermore, the

Declaration is of little or no probative value since the statement "the viscosity of the binder composition described above would not necessarily be in the range of from 20 cP to 100cP" is not made with any degree of certainty.

Conclusion

7. The additional prior art to Hummerich et al (U.S. 6,071,994), listed on the attached FORM PTO 892, is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
01/27/05